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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/379,589    08/24/99    ROBERTS    D    1364.1001D5/

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TM02/0504

EXAMINER

VU, V

ART UNIT

PAPER NUMBER

2154

*16*

DATE MAILED:

05/04/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Office Action Summary

Application No.

09/379,589

Applicant(s)

Roberts et al

Examiner

V. Ju

Group Art Unit

2154

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3-20-01
- ☒ This action is **FINAL**
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-97 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-28, 31-63, 65-72, 74, 76-78, 80-97 is/are rejected.
- ☒ Claim(s) 29, 30, 64, 73, 75, 79 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
  - ☐ received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**DETAILED ACTION**

**Art Rejections:**

1. The texts of 35 U.S.C. 102(b) and 103 not cited here can be found in the previous office action.

2. Claims 2-3, 22, 40-41, 43, 62, 71, 76-77, 81-82 and 93-97 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Fischer, U.S. pat. No. 4,599,644.

Fischer discloses a system for transferring information associated with playback of a recording comprising:

**a)** a first device (3, fig.2) to reproduce a recording stored in a medium (26, fig. 2) possessed by a user, and to collect use data associated with the recording (see col 4, lines 33-48 and col 5, lines 16-29),

**b)** means (15, fig. 2) for processing/storing collected use data at the first device (col 4, lines 48-58),

**c)** a remote second device to receive and evaluate use data, and

**d)** means (6, fig. 2) for establishing a connection between the first and second devices to transfer the use data from the first device to the second device (see col 4, lines 4-8).

3. Claims 4, 16-17, 44-45, 54-55, 72, 74, 78, 80 and 83-92 are rejected under 35 U.S.C. § 103 as being unpatentable over Fischer in view of Kaplan, U.S. pat. No. 5,237,157.

Fischer's teachings are still applied as discussed above. Fischer does not explicitly teach collecting user demographics data. Collection of user demographic data during the playback/preview of a plurality recording medium including music CDs, movies, etc., for marketing purpose is well-known in the art as disclosed by Kaplan (see Kaplan's col 5, lines 30-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fischer with Kaplan's teachings because it would have enabled Fischer to obtain user demographics data for marketing purposes (see Fischer's col 1, lines 30-35).

4. Claims 5-6, 18-19, 27-28, 31-32, 35-38, 46-47, 56-57, 63 and 65-70 are rejected under 35 U.S.C. § 103 as being unpatentable over Fischer and Kaplan and further in view of Palmer, U.S. pat. No. 5,905,865.

Fischer does not teach transferring complimentary data to user based upon use data and user demographics. Palmer teaches providing complimentary data to users based upon watched programs

(use data) and user profiles/demographics (see Palmer's col 6, lines 49-64 and col 7, lines 27-39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fischer with Palmer's teachings because it would have provided an enhanced method of delivering of product/service advertisement to potential users (see Palmer's col 6, lines 47-50).

Palmer also teaches storing the broadcast programs in different medium (see Palmer's col 8, lines 5-13).

5. Claims 7-15, 20-21, 23-26, 39, 42, 48-53 and 58-61 are rejected under 35 U.S.C. § 103 as being unpatentable over Fischer and Palmer and further in view of Dedrick, U.S. pat. No. 5,710,884.

Neither Fischer nor Palmer teach monitoring other user activity during user's session, e.g., length, frequency, etc. Such monitoring of user's computer and user's activity for marketing purpose is well-known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Fischer and Palmer with Dedrick's teachings of data monitoring because it would have enabled the server to compile a more complete user profile for use by advertisers.

**Allowable Subject Matter:**

6. Claims 29-30, 64, 73, 75 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Response to Amendment:**

7. Applicant's arguments filed on 3/20/01 are not found persuasive.

Applicant alleges that Fischer fails to teach the claimed invention because Fischer's embedded codes, which are used to identify programs played by a user, are NOT "information obtained from contents of the recording used for playback to a user".

This is not found persuasive. Since these identifying codes are embedded and stored along with the broadcast program on a fixed medium (e.g., VCR magnetic tape), these codes are part of contents of the recording. The examiner fails to find any specific language in the current claims to warrant the alleged exclusion of certain data such as theses identifying codes from the contents of the recording. Moreover, the identifying codes are also played (invisually) to user during the playback of the recording. Thus, it is submitted that Fischer's embedded codes ARE in fact

Serial No. 09/379,589

"information obtained from contents of the recording used for playback to a user".

**Conclusion:**

8. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678.

Serial No. 09/379,589

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU**  
**PRIMARY EXAMINER**

Art Unit 2154  
5/1/01